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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 7000-091	
I hereby certify that this correspondence is being transmitted via facsimile on the date indicated below to: Examiner: David Armand Wiley Art Unit: 2143 Fax Number: 703-872-9306 on <u>July 26, 2005</u> Signature <u>Rebecca A. Rooks</u> Typed or printed name <u>Rebecca A. Rooks</u>		Application Number 09/973,412	Filed 10/09/2001
		First Named Inventor Paul T. Brescia	
		Art Unit 2143	Examiner David Armand Wiley
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. 40,876 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature Benjamin S. Withrow Typed or printed name 919-654-4520 Telephone number July 26, 2005 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required. see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Paul T. Brescia
Serial No. 09/973,412
Filed: 10/09/2001
For: LOCATION-BASED ADDRESS PROVISION

Examiner: Wiley, David Armand
Art Unit: 2143

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The current remarks provide the succinct, concise, and focused set of arguments for which the review is being requested and accompany the concurrently filed Notice of Appeal. Applicant has enclosed a Credit Card Form authorizing payment of \$500.00 to cover the cost of the Notice of Appeal. If any additional fees are required in association with this response, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

REMARKS

Applicant files the Request for a Pre-Appeal Brief Review of the application so that the panel of Examiners may determine whether the Office Actions of record adequately establish two things. Applicant first queries whether the Patent Office has adequately established a suggestion to combine the references for a rejection under 35 U.S.C. § 103. Applicant second queries whether the Patent Office has established *prima facie* obviousness since the references of record do not teach or suggest “establishing a plurality of unique internet protocol addresses from each of which unique content may be accessed. . .” or “associating each of the plurality of unique internet protocol addresses with different geographic locations. . .” as recited in the claims.

A. The Patent Office Has Not Established a Motivation to Combine the References

The Federal Circuit has set forth the requirement that the Patent Office must do two things to show a suggestion to combine references in an obviousness rejection. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). While the range of sources may be broad, the number of available sources does not diminish the requirements for actual evidence. Applicant argued in the Response filed June 20, 2005, page 8, lines 16-31 that the Patent Office has not satisfied this requirement. As noted therein, the Patent Office has provided no evidence that that the combination would result in the customization of content at the intermediate node as the Patent Office has asserted. Since the Patent Office’s evidence does not establish the motivation to combine the references, the combination is improper. The combination is especially improper in light of the fact that the combination renders one of the references unsuitable for its intended purpose as argued in the Response filed June 20, 2005, page 9, lines 1-14. Applicant requests that the rejection of the claims be withdrawn for this reason.

B. The Combination Does Not Establish *Prima Facie* Obviousness

In the Response filed June 20, 2005, page 9, line 15 and extending to page 11, line 22, Applicant explained why the citations of record to the various references do not show the recited claim element “establishing a plurality of unique internet protocol addresses from each of which unique content may be accessed. . .” Applicant addressed each of the citations provided by the Patent Office, and it is clear that the references do not teach this element based on the Patent

Office's citations. In the Advisory Action of July 6, 2005, the Patent Office also pointed to Heddaya (U.S. Patent No. 6,662,157) column 6, lines 15-20 and lines 45-50, arguing that these passages taught the claim element. Applicant has studied this passage and finds no teaching or suggestion therein. While the passages do describe internet URLs and TCP/IP layered protocols, there is no plurality of unique internet protocol addresses from each of which unique content may be accessed as recited in the claims.

Applicant also maintains that, as explained in the Response filed June 20, 2005, page 11, line 22 and extending through page 12, line 20, the Patent Office has not shown where "associating each of the plurality of unique internet protocol addresses with different geographic locations. . ." is located in the references.

Since the references of record, alone or in combination, do not teach or suggest all the claim elements, the Patent Office has not established *prima facie* obviousness. Applicant requests withdrawal of the rejection under 35 U.S.C. § 103 for this reason as well.

Applicant requests that the panel of Examiners review the arguments previously presented and determine whether the Patent Office has established a proper motivation to combine the references and shown where all the claim elements are taught or suggested. If the panel determines that either of these requirements have not been met, Applicant requests withdrawal of the rejection and claim allowance.

CERTIFICATE OF TRANSMISSION I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING TRANSMITTED VIA FACSIMILE ON THE DATE INDICATED BELOW TO:
Examiner: <u>Wiley, David Armand</u> Art Unit: <u>2143</u> Fax: <u>703-</u> <u>872-9306</u>
<u>REBECCA ROCKS</u> Name of Sender
<u>Rebecca A. Roody</u> Signature
<u>7-26-05</u> Date of Transmission

Respectfully submitted,

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Date: July 26, 2005

Attorney Docket: 7000-091